

REMARKS

This is in response to the Decision of the Board of Patent Appeals and Interferences affirming the Final Rejections stated by the Examiner in the FINAL Official Action dated 15 September 2005.

Claims 1-4 and 6-17 were present in this application at the time of the Board of Patent Appeals and Interferences affirmed the outstanding FINAL Official Action in the above-identified application. The present Amendment amends Claims 1 and 14. No Claims have been added or withdrawn. Accordingly, upon the entry of the foregoing Amendment, the claims under active prosecution in this application will be Claims 1-4 and 6-17.

The claims as they will stand upon the entry of the foregoing Amendment are set forth in full herein as required by the Rules.

In the currently outstanding Official Action, the Examiner has:

1. Acknowledged Applicants' claim of foreign priority under 35 USC 119(a)-(d), and to confirmed the safe receipt of the priority document for this application by the United States Patent and Trademark Office;
2. Rejected Claims 1-4, 6-10, 12, 16-17 under 35 USC 103(a) as being unpatentable over Suzuki (US Patent No. 5,923,013) in view of Tanaka et al (hereinafter referred to as Tanaka (US Patent No. 5,682,549));
3. Rejected Claims 11 under 35 USC 103(a) as being unpatentable over Suzuki in view of Tanaka as applied to claim 1 and further in view of Morikawa (US Patent No. 5,960,247);
4. Rejected Claim 13 under 35 USC 103(a) as being unpatentable over Suzuki in view of Tanaka as applied to claim 1 and further in view of Kusumoto (US Patent No. 6,088,135);

No further comment regarding item 1 above is deemed to be required in these Remarks.

With respect to items 2 through 4 above, Applicants respectfully request entry of the above stated amendments to Claims 1 and 14, and reconsideration of this application as so amended.

In the recent Appeal of the Examiner's FINAL rejection, Applicants in their Brief on Appeal argued that there is a significant difference between the present invention and the Suzuki reference. In particular, it was pointed out that the present invention manages input image data on an "each input image data" basis while the Suzuki reference manages the input image data on a "print out page" basis. In addition, by way of examples, Applicants utilized a "jam" of recording media and a failure of a memory in the case of printing 4 page images on one sheet of recording media to point out how the present invention allows for the read out of input and stored input image data such that the readout operation can be stopped and restarted from the point that the stoppage took place. Applicants further emphasized the increase in efficiency this mode of operation provides over the prior art relied upon by the Examiner.

The Board apparently disagreed on the basis the claims pending on Appeal do not define the details of the image processing. In other words, the claims on Appeal were deemed to be so broad as to cover a device in which all of the image processes are set "through" as shown in Figs. 6(a) and 6(b). Thus, the Board stated in its decision that:

"...Although a page of the image or images of a document relate to the output after the input request and input complete steps are finished, there is nothing in the specification that requires inputting multiple images for each page. In particular, the claims merely recite "image data" and "image basis" without any reference to how the image data corresponds to a page. In determining the scope of claim 1, limiting the term "image data" to something necessarily less than a page, would have placed us on the wrong side of the fine line between reading a claim in light of the specification, and reading a limitation from the specification into the claim (citation omitted) Here, although the specification allows the break up of a page into multiple images, neither the specification precludes an image data constituting a page image nor the claims require multiple images for each page. (Decision of Board Of Appeals and Interferences if 15 September 2005, at Page 5, line 20 to Page 6, line 13, Emphasis added)

In view of the foregoing, Applicants by the above Amendment (in addition to minor grammatical changes to some of the claims) have added the limitation “said image processing means has a processing mode for generating a printout page from a plurality of input image data” (Emphasis Added) to each of the independent claims of this application, i.e., Claims 1 and 14. This amendment is based upon the explanations of Figs. 9(a) and 9(b) in the specification at page 52, line 21 to page 54, line 7. In this regard it also is respectfully submitted that since the relationships of input image data and the printout image are clear from Figs. 8, 9 and 10, it will be readily understood that the present invention contemplates that it is to be possible to carry out the jam recovery and other examples discussed in detail in Applicants’ Brief on Appeal with the presently claimed apparatus. Applicants respectfully submit that the present amendment clarifies this point and states the limitations of the claims of this application in a manner that overcomes the Board’s apparent objection to the breadth with which the claims of this application were previously stated.

Accordingly, in view of the foregoing Amendment and Remarks taken in the context of the examples discussed in detail in Applicants’ Brief on Appeal, Applicants respectfully submit that the claims of this application as amended hereinabove are now in condition for allowance. Consequently, reconsideration and allowance of Claims 1-4 and 6-17 as hereinabove amended in response to this communication are respectfully requested in response to this communication.

Applicants also believe that additional fees beyond those submitted herewith are not required in connection with the consideration of this Amendment Accompanying Submission of Request for Continued Examination. However, if for any reason a fee is required, a fee paid is inadequate or credit is owed for any excess fee paid, you are hereby authorized and requested to charge and/or credit Deposit Account No. **04-1105**, as necessary, for the correct payment of all fees which may be due in connection with the filing and consideration of this communication.

Respectfully submitted,

Date: November 15, 2005


SIGNATURE OF PRACTITIONER

Reg. No. 27,840

David A. Tucker
(type or print name of practitioner)
Attorney for Applicant

Tel. No. (617) 517-5508

Edwards Angell Palmer & Dodge LLP
P. O. Box 55874
P.O. Address

Customer No. 21874

Boston, MA 02205

516701